

REMARKS

Claims 1-7 remain in this application. Claim 1 was amended to better define the scope of the invention, and claim 4 was cancelled without prejudice. No new matter has been introduced as a result of this amendment. Favorable reconsideration is respectfully requested.

Claims 1-2, 4 and 5-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Nagel et al.* (US Patent No. 5,481,399) in view of *Chawki et al.* (US Patent No. 5,576,875). Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Nagel et al.* (US Patent No. 5,481,399) in view of *Chawki et al.* (US Patent No. 5,576,875) and further in view of *Strasser et al.* (US Patent No. 5,576,875) or *Hemmi* (US Patent No. 5,576,875). Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Nagel et al.* (US Patent No. 5,481,399) in view of *Chawki et al.* (US Patent No. 5,576,875) and further in view of *Aida et al.* (US Patent No. 5,005,937). The Applicants respectfully traverse these rejections.

Specifically, the cited art, alone or in combination does not disclose a "wavelength demultiplexer filter device has low stop-band attenuation only for individual optical signals which are in transmission channels, and further having a high stop-band attenuation outside the transmission channels for a wavelength range containing said instabilities" and a "a multiplexer device for combining the individual signals into a wavelength division multiplex signal" as recited in claim 1. *Nagel* discloses an optical amplifier having a filter (24) used as a drop element to help eliminate the ASE peaks and drops in a service signal having the same wavelength (col. 4, lines 4-15). The configuration disclosed in *Nagel* however, does not teach the use of demultiplexer filter devices for ring networks where the filter device has different attenuations at different wavelengths in the transmission channels.

Chawki and *Henmi*, however, do not cure the deficiencies of *Nagel*. While both references teach the use of add/drop filters in a ring network system, neither reference addresses instability problems in the ring network according to the characteristics of the filters as claimed above. Furthermore, there is no teaching or suggestion to combine these references without the use of impermissible hindsight. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills* 916 F.2d at 682, 16 USPQ2d at 1432 (PEP 2143.01). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

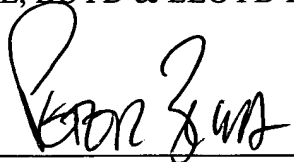
be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143).

With regard to claim 1, the Examiner claimed that "it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate an optical add-drop filter such as the one of *Nagel* in a multiplex ring network, as it is taught by *Chawki*, in order to add and drop specific channels within the network and to suppress noise signals." This rationale is simply incorrect. *Nagel* expressly uses a filter to remove telemetry signals in EFDA regenerative systems (see col. 1, line 60 to col. 2, line 15; col. 4, lines 45-53). *Chawki*, on the other hand, deals with the use of filters to extract data from transmissions using multiple wavelengths in order to minimize the number of lasers used in the system (col. 3, lines 63 to col. 4, line 2). What teaching is there in the references would motivate one skilled in the art to combine these references? *Chawki* does not use the filters to eliminate noise per se, but instead teaches the use of Fabry-Perot type filters to transmit a narrow band of wavelengths and reject wavelengths outside of that band (col. 4, line 14, 54). The filter has ability to "select" a different peak wavelength as the filter is tilted. By substituting the filters of *Nagel*, the system becomes inadequate for its intended purpose (see MPEP 2143.01).

In light of the above, Applicants respectfully submit that independent claim 1, as well as all claims that depend therefrom, are in condition for allowance, which is respectfully requested.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Peter Zura
Reg. No. 48,196
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4354

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